



PATENT
Attorney Docket No. A-67229-13
Dorsey File No. 463077-00245

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

DAHIYAT et al.

Serial No.: 10/665,307

Filing Date: September 18, 2003

For: *Protein Design Automation for Protein Libraries*

Examiner: Wessendorf, Teresa D.

Art Unit: 1639

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed enclosures, is being deposited with sufficient postage with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on:

Dated: 9/24/04

Signed: Jessica L. Newlin
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**INFORMATION DISCLOSURE STATEMENT
AND
STATEMENT OF RELATEDNESS**

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

In satisfaction of the duty of disclosure under 37 C.F.R. § 1.56, and in accordance with the provisions of 37 C.F.R. §§ 1.97 and 1.98, Applicants wish to draw the attention of the U.S. Patent and Trademark Office to the references cited on the accompanying form PTO/SB/08A-B, Substitute for form PTO 1449. This application is a divisional of U.S. Application Serial No. 09/782,004, filed February 12, 2001 (pending). The references cited on the accompanying form PTO/SB/08A-B, Substitute for form PTO-1449, not marked with an asterisk (*), were previously disclosed in the above-mentioned application and in accordance with 37 C.F.R. § 1.98(d), no copies of these references are enclosed.

Serial No.: 10/665,307
Filing Date: September 18, 2003

Further, in accordance with 1273 Off. Gaz. Pat. Off. 1, 8/5/2003, no copies of U.S. patents and U.S. published applications are enclosed. Copies of all other references are enclosed.

With respect to patent applications, the applicants point out their duty under M.P.E.P. §2001.06(b) to disclose relevant patent applications of which they are aware. To this end, the applicants draw the Examiner's attention to the following patent application:

1. U.S.S.N. 10/888,748, filed July 9, 2004.

Nothing herein shall constitute an admission concerning the contents of any of the cited references, nor shall the inclusion of a reference herein be considered an admission that the reference constitutes prior art against the invention claimed in the above-identified application. Submission of the present document shall not be construed as an admission that a search has been made or that better art does not exist.

Pursuant to 37 C.F.R. § 1.97(c), enclosed is a check in the amount of \$180.00 as set forth in 37 C.F.R. § 1.17(p). While no further fee is believed to be due, if this belief is in error, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-2319 (Our Order No. 463077-00245 (A-67229-13/RFT/RMS/RMK)).

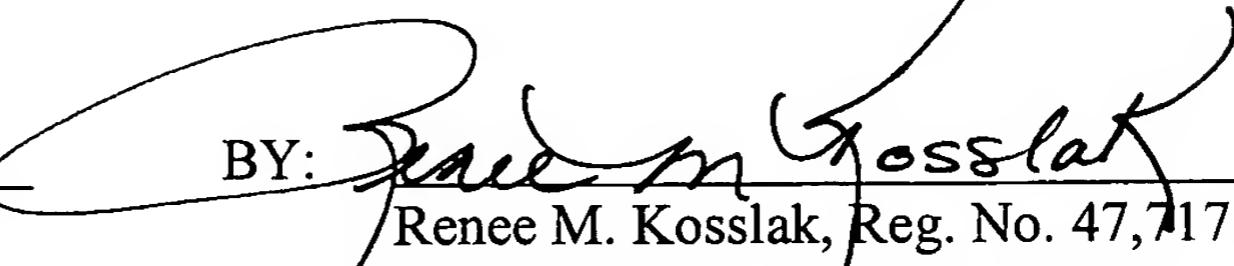
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Serial No.: 10/665,307
Filing Date: September 18, 2003

Please direct any calls in connection with this application to the undersigned at
(415) 781-1989.

Respectfully submitted,
DORSEY & WHITNEY LLP

Dated: 9/24/04
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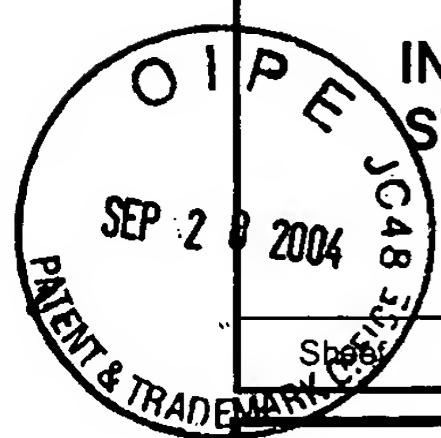
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Renee M. Kossak, Reg. No. 47,717 for
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Attachments:

Form PTO/SB/08A-B, Substitute for form PTO 1449
3 references

<p>Substitute for form 1449A/PTO (Modified)</p> <p>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</p> <p>(use as many sheets as necessary)</p>				Complete if Known	
				Application Number	10/665,307
				Filing Date	September 18, 2003
				First Named Inventor	DAHIYAT, Bassil I.
				Art Unit	1639
Examiner Name	Wessendorf, Teresa D.				
Sheet	1	of	5	Attorney Docket Number	A-67229-13



U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	U.S. Patent Document Number-Kind Code ² (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
	A1	4,939,666	07-03-1990	Hardman	
	A2	5,241,470	08-31-1993	Lee et al.	
	A3	5,265,030	11-23-1993	Skolnick et al.	
	A4	5,527,681	06-18-1996	Holmes	
	A5	5,878,373	03-02-1999	Cohen et al.	
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	A7	6,269,312 B1	07-31-2001	Mayo et al.	
	A8 *	6,403,312 B1	06-11-2002	Dahiyat et al.	
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	A10 *	2001/0032052 A1	10-18-2001	Mayo et al.	
	A11 *	2001/0039480 A1	11-08-2001	Mayo et al.	
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	A18 *	2004/0043430 A1	03-04-2004	Dahiyat et al.	

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Foreign Patent Document Country Code ² Number ⁴ Kind Code ⁵ (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
	B1 *	EP 0 974 111 B1	01-26-2000	California Institute of Technology		
	B2	WO 95/22625 A1	08-24-1995	Affymax Technologies N.V.		
	B3	WO 98/32845 A1	07-30-1998	Bioinvent International AB		
	B4	WO 98/47089 A1	10-22-1998	California Institute of Technology		
	B5	WO 00/23564 A2	04-27-2000	Xencor, Inc.		
	B6	WO 00/68396 A2, A3	11-16-2000	Xencor, Inc.		
	B7 *	WO 01/59066 A2, A3	08-16-2001	Xencor, Inc.		
	B8 *	WO 03/014325 A2, A3	02-20-2003	Xencor		

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<p>Substitute for form 1449A/PTO (Modified)</p> <p>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</p> <p>(use as many sheets as necessary)</p> <p>SEP 28 2004 PATENT & TRADEMARK OFFICE</p>			Complete if Known	
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			Filing Date	September 18, 2003
			First Named Inventor	DAHIYAT, Bassil I.
			Art Unit	1639
			Examiner Name	Wessendorf, Teresa D.
2	of	5	Attorney Docket Number	A-67229-13

NON PATENT LITERATURE DOCUMENTS

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	C1	BORMAN, "Proteins to Order," C&EN, 1997, pp.9-10.	
	C2	BOWIE et al., "A Method to Identify Protein Sequences That Fold into a Known Three-Dimensional Structure," Science, 1991, 253(5016):164-170.	
	C3	BOWIE et al., "Deciphering the Message in Protein Sequences: Tolerance to Amino Acid Substitutions," Science, 1990, 247:1306-1310.	
	C4	BRENNER et al., "A quantitative methodology for the de novo design of proteins," Protein Science, 1994, 3:1871-1882.	
	C5	BROOKS et al., "CHARMM: A Program for Macromolecular Energy, Minimization, and Dynamics Calculations," Journal of Computational Chemistry, 1983, 4(2):187-217.	
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	C8	DAHIYAT et al., "Protein Design Automation," Protein Science, 1995, 4(2):83.	
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Examiner Signature		Date Considered	
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				Art Unit	1639
				Examiner Name	Wessendorf, Teresa D.
Sheet	3	of	5	Attorney Docket Number	A-67229-13

NON PATENT LITERATURE DOCUMENTS

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	C22	DESMET et al., The "Dead-End Elimination" Theorem: A New Approach to the Side-Chain Packing Problem," The Protein Folding Problem and Tertiary Structure Prediction, 1994, Ch. 10:1-49.	
	C23	DUNBRACK et al., "Conformational analysis of the backbone-dependent rotamer preferences of protein sidechains," Nat. Struct. Biol. , 1994, 1(5):334-40.	
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	C38	KONO et al., "Energy Minimization Method Using Automata Network for Sequence and Side-Chain Conformation Prediction From Given Backbone Geometry," Proteins: Structure, Function and Genetics , 1994, 19(3):244-255.	
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		Application Number		10/665,307	
		Filing Date		September 18, 2003	
		First Named Inventor		DAHIYAT, Bassil I.	
		Art Unit		1639	
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NON PATENT LITERATURE DOCUMENTS

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	C41	LASTERS et al., "Dead-End Based Modeling Tools to Explore the Sequence Space that is Compatible with a Given Scaffold," Journal of Protein Chemistry, 1997, 16(5):449-452.	
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	C45	LIM et al., "The crystal structure of a mutant protein with altered but improved hydrophobic core packing," Proceedings of the National Academy of Sciences USA, 1994, 91:423-427.	
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	C59	SUN et al., "Designing amino acid sequences to fold with good hydrophobic cores," Protein Engineering, 1995, 8(12):1205-1213.	
	C60	TUFFERY et al., "A New Approach to the Rapid Determination of Protein Side Chain Conformations," Journal of Biomolecular Structure & Dynamics, 1991, 8(6):1267-1289.	

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	C61	VAN GUNSTEREN et al., "Prediction of the Activity and Stability Effects of Site-directed Mutagenesis on a Protein Core," J. Mol. Biol., 1992, 227:389-395.	
	C62	VILLEGAS et al., "Stabilization of proteins by rational design of α -helix stability using helix/coil transition theory," Folding & Design, 1995, 1(1):29-34.	
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